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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,059	01/11/2002	Satoshi Otsuka	204935-9001	6540

7590 04/21/2005

Michael Best & Friedrich LLC
401 North Michigan Avenue
Chicago, IL 60611

EXAMINER

ADDY, ANTHONY S

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/044,059	Applicant(s) OTSUKA, SATOSHI8	
	Examiner Anthony S Addy	Art Unit 2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07/20/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claim 4 is rejected under 35 U.S.C. 102(e) as being anticipated by **Nagasawa, U.S. Patent Number 6,782,281 (hereinafter Nagasawa)**.

Regarding claim 4, Nagasawa teaches a portable telephone set (see col. 3, lines 39-48 and Figures 1A-2B) comprising: an additional function unit that provides at least one of a game and a music reproduction (see col. 5, lines 17-22, col. 6, lines 5-11 and Fig. 6; where a controller (28) for pocket game is shown for a portable telephone set); a communication function unit (see col. 4, lines 63-66, col. 5, lines 6-10 and Fig. 6; where a radio communications section 21 is shown of a portable telephone set); and a stopping means linked with the communication function unit and having a first stop mode for stopping operation of the communication function unit and in response to the stopping of the communication function unit being repeatedly operative for a predetermined time for checking the presence of one or more of an arriving call and a mail addressed to the telephone set and displaying an ICON relative thereto on a display (see col. 6, lines 13-47), and a second stop mode for holding the communication function unit in a de-energized state so that the additional function unit may operate

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without interruption from the communication function unit relative to an arriving call and a mail (see col. 6, lines 28-47) and it is inherently disclosed by Nagasawa the communication function unit is in a de-energized state, since Nagasawa teaches when there is an incoming call and the caller information is displayed and when the call start button is not pressed but the start button for a pocket game is pressed, a message stored in memory in advance is sent to release the call, without forcibly suspending the pocket game [see col. 6, lines 28-47], thus it is inherently disclosed the transmitter and receiver of the portable telephone is in a de-energized state).

Regarding claim 5, Nagasawa teaches all the limitations of claim 4. In addition, Nagasawa teaches a portable telephone set, wherein the ICON comprises one or more of a telephone number of a calling party for the arriving call and a sender's address for the mail (see col. 5, lines 44-47 and col. 6, lines 15-18).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Nagasawa, U.S. Patent Number 6,782,281 (hereinafter Nagasawa)** as applied to claim 4 above, and further in view of **Shimanuki, U.S. Patent Number 5,890,071 (hereinafter Shimanuki)**.

Regarding claim 6, Nagasawa teaches all the limitations of claim 4. Nagasawa fails to explicitly teach a stop switch that is interposed between a power supply and the communication function unit.

Shimanuki, however, teaches a radio telephone set with broadcast receiving functions, wherein the power supply section comprises: a power supply for outputting electric power for a receiving system of the telephone section, the tuner section and the other elements that need power supply; and power supply switches for switching electric power for the telephone section and the tuner section (see col. 3, lines 61-67 and Fig. 1; where power supply switches 22 & 23 interposed between a power supply 21 and communication function unit is shown).

It would therefore have been obvious to one of ordinary skill in the art to modify the radio telephone set with broadcast receiving functions, wherein the power supply section comprises; power supply switches for switching electric power for the telephone section and the tuner section as taught by Shimanuki with the folding portable telephone set of Nagasawa in order to save power in a wait state by means of intermittent receiving operation in which the power supply is switched on and off alternately.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Nagasawa, U.S. Patent Number 6,782,281 (hereinafter Nagasawa)**, and further in view of **Yoon et al., U.S. Patent Number 6,628,971 (hereinafter Yoon)**.

Regarding claim 3, Nagasawa teaches a portable telephone set (see col. 3, lines 39-48 and Figures 1A-2B) comprising: a control means having a first operating mode for providing telephone functions (see col. 5, line 63 through col. 5, line 14 and Fig. 6; where a controller 22 for providing telephone functions is shown) and a second operating mode for providing additional functions (see col. 5, lines 17-25 and Fig. 6; where a controller 28 for providing a game function is shown); a radio communicating

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means linked with the control means and operable to send and receive radio communications with a base station in the first operating modes (see col. 5, line 63 through col. 5, line 10 and Fig. 6; where a radio communications section 21 coupled to controller 22 is shown) and de-energized in the second operating mode (see col. 6, lines 28-47 and it is obvious Nagasawa teaches the radio communicating means is de-energized in the second operating mode, since Nagasawa teaches when there is an incoming call and the caller information is displayed and when the call start button is not pressed but the start button for a pocket game is pressed, a message stored in memory in advance is sent to release the call, without forcibly suspending the pocket game [see col. 6, lines 28-47], thus it is obvious the transmitter and receiver of the portable telephone is in a de-energized state); a manipulating unit linked with the control means and including a telephone function stop key (see col. 6, lines 21-22, col. 4, lines 17-25 and Fig. 6; where a key operation area 26 constituting a manipulating unit linked with controller 28 is shown), the manipulating unit providing a stop signal to the control means that switches the control means between the first and second operating modes when the telephone function stop key is pressed (see col. 6, lines 5-25); and a display means linked with the control means for displaying various data (see col. 4, line 66 through col. 5, line 3, col. 5, lines 44-53 and Figures 2B & 12B)

Nagasawa, however fails to explicitly teach the control means is operative to render the radio communicating means operative when a predetermined time has passed after the control means receives the stop signal, then check whether a mail

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addressed to the telephone set is present on a mail server, and display a mail ICON indicative of the mail on the server on the display means.

Yoon discloses a method for displaying background image in a mobile telephone, which downloads background images in a memory, and displays a selected one of the stored background images. The method comprises the steps of displaying the selected image for a predetermined time, in a background image request condition; determining whether an urgent character message display condition has occurred while the background image is displayed; upon detection of the urgent character message display condition, stopping the display of the background image and displaying the urgent character message (see col. 3, line 3 to col. 4 line 37 and Fig. 3).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to modify the telephone set of Nagasawa to display an urgent character message, such as a voicemail or text message notification so that the telephone set will have that advantage, as per the teachings of Yoon.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony S Addy whose telephone number is 571-272-7795. The examiner can normally be reached on Mon-Thur 8:00am-6:30pm.

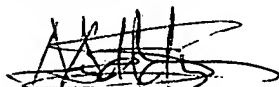
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Anthony S. Addy', with a large, stylized flourish at the end.

Anthony S. Addy

April 7, 2005

A handwritten signature in black ink, appearing to read 'Temica M. Beamer', with a large, stylized flourish at the end.

TEMICA BEAMER
PRIMARY EXAMINER